



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,660	03/16/2004	Yukako Taka	02860.0782	4730

22852 7590 09/28/2005

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

SCHWARTZ, PAMELA R

ART UNIT	PAPER NUMBER
----------	--------------

1774

DATE MAILED: 09/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/800,660

Applicant(s)

TAKA ET AL.

Examiner

Pamela R. Schwartz

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1774

1. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohbayashi et al. (6,432,550) in view of either of Ashida et al. (JP02001096898A) or Kasahara et al. (2003/0186020) for reasons of record and for reasons given below.
2. Applicant's arguments filed July 21, 2005 have been fully considered but they are not persuasive. However, the rejection under 35 U.S.C. 102 has been withdrawn in view of applicants' remarks.

Applicants point out that the Cobb value of the reference is for the resin-coated support while their claimed value is for the paper support prior to coating with resin. Even so, the reference still appears to obviate the claims. First, the paper employed in the support of the reference appears to be formed from the same method as applicants paper support, and includes the same types of additives, i.e. sizing agents, talc, paper strength enhancing agents, etc. (see col. 5, lines 23-63). The paper may be sized internally and on the surface. The reference discloses Cobb-water-permeability with respect to the support overall. The disclosure is that the value should be at most 5 g/m² and preferably is 0 g/m². The reference also states that a support that has low humid absorbability is preferred to avoid through image visibility (see col. 4, lines 17-27 of the reference). Therefore, the reference teaches the importance of resistance to water and humidity.

Based upon these disclosures, one of ordinary skill in the art would have found it obvious to use a base paper with humidity and water resistance properties and to coat the base paper with resin as disclosed by the primary reference. Therefore, the reference suggests use of a base paper with a low Cobb value. It wouldn't make sense

Art Unit: 1774

to allow humidity to enter the edges of the support by selection of a paper base sheet that was susceptible to contact with humidity or water. Therefore, inclusion of paper with a low Cobb value would have been obvious to one of ordinary skill in the art.

With respect to the examples of the reference, as pointed out by applicants, only one is resin coated and this one has a Cobb value of 0 g/m^2 . Therefore, a direct comparison with applicants' claimed values cannot be made. It is noted that once resin coated, applicants' support will also have a Cobb value of 0 g/m^2 , therefore this is a way that applicants' invention is like the prior art, rather than a distinction from it. While the reference does not explicitly recite applicants' Cobb value for the base paper, a low Cobb value would have been suggested by the disclosure of the reference. The secondary art was not relied upon for teachings of the Cobb value so applicants' arguments concerning the failure of the secondary art to teach these values are unpersuasive.

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 1774

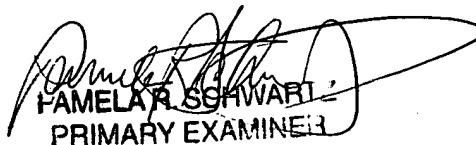
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela Schwartz whose telephone number is (571) 272-1528.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRSchwartz
September 23, 2005


PAMELA R. SCHWARTZ
PRIMARY EXAMINER